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10/664,429

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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/664,429
Filing Date: September 16, 2003
Appellant(s): GLENNA ET AL.

Alan M. Koench
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 15, 2008 appealing from the Office action mailed January 3, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,512,462	DILLS	4-1985
2,015,268	HAMMOND	9-1935
2,329,527	GOLUB	9-1943

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-17, 20-25 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dills (4512462) in view of Hammond (2015268).

Dills relates to a tape roll comprising a central tape roll axis, a length of adhesive tape (16) is circumferentially wound about the axis, a tab (10) is adhered to the adhesive surface of the trailing end of the tape and is, in turn, adhered to the penultimate layer of the tape. As shown in figure-3, the tab has at least one hole (18) and that the trailing end of the tape is located between the ends of the tab. The tab can be of paper (col. 2, lines 18-19) which is known to be opaque or polyethylene (col. 3, lines 23), that is known to be transparent. However, Dills fails to teach that the tab has adhesive on its second side which is adhered to the first side of the tape. Hammond

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discloses adhesive tape tab comprising an adhesive strip (c) with perforations (d) in figure-3. In figure-2, Hammond teaches that the tab has adhesive portions (g) and adhesive deadened portions (f). Hammond shows that providing adhesive on a tab with hole or without hole, including adhesive and non-adhesive portions, are equivalent structure known in the art. Therefore, because these two adhesive tabs with holes and adhesive tab without holes were art recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute Hammond's adhesive tab without holes for Dills' tab with at least one hole.

As shown in Hammond, figures-2 and 4, the tab has adhesive portion adjacent the second end of the tab and non-adhesive portion adjacent the first end of the tab, and that the non-adhesive portion is formed by the deadening sections (f).

Since the strip stays with the tape (figure-1), upon lifting of the trailing end, the adhesive strength of the tab is greater than that of the tape. Figure-4 shows that the adhesive strength is the same as that of the tape because the tab is split.

For claims 24 and 25, the provision of limited adhesive surface being exposed to adhere the tab will provide for less adhesive strength and also repositionability.

Claims 19 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dills in view of Hammond and Golub (5329527).

Dills and Hammond, as discussed above, fails to teach that the tab comprises an adhesive over its entire second side. Golub discloses an adhesive tab (figures 2 and 8) with adhesive coated over the entire surfaces to provide for enhanced adhesion of the trailing end of the tape to the

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penultimate layer via the tab. The tab is figure-2 also is shown to be a laminate. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Golub's teaching of providing adhesive coating over the entire second surface of the tab in the invention of Hammond with the motivation to provide for enhanced adhesion.

Allowable Subject Matter

8. Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art fails to teach or suggest that the tab comprises at least a portion of the adhesive portion of the second side is folded and adhered to the second side of the tab to provide the non-adhesive portion.

(10) Response to Argument

Applicant argues that there is no teaching or suggestion to combine Dills with Hammond. This is not found to be convincing because, as agreed by the applicant, dills relates to a tab (10) with a hole (18) in it and fails to teach the presence of adhesive on its second side. Hammond teaches that the tab (c) can be with holes (d) or without holes (g). Hammond also teaches in col. 2, lines 25-27, that the strip (c) of paper tab **may be** punched with a series of holes, wherein the phrase "may be" is interpreted to be with holes or without holes. Further, in col. 2, line 50-52, Hammond clearly teaches that the strip **may be** provided with one adhesive face adhesive. Again, it is the examiner's position that the phrase "may be" herein is interpreted

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to be with or without adhesive. Then, in col. 3, lines 5-10, Hammond teaches that the tab strip can be of wax, oiled paper, etc. with holes. It is noted that herein no mention of any adhesive is given by Hammond. Thus, Hammond clearly discloses that the tab strip can be with or without holes and can be with or without adhesive thereon. So, when the strip has holes with adhesive, it would be equivalent in function to the tap strip with hole and no adhesive as taught by Dills.

In response to applicant argument that Examiner has not provide any specific motivation that would suggest the proposed modification, it is noted that the rejection is based on obvious functional equivalency of the tab with hole and adhesive to tab with hole and without adhesive.

Applicant is also directed to Hammond, col. 3, lines 5-10 wherein it is stated that the holes provides for adhesion between the gummed face of the tap and the coiled body (which would be the penultimate layer).

Applicant argues that the art-known equivalency is misapplied because the suggestion or motivation to combine the teachings of dills and Hammond is lacking. This is not found to be persuasive because, as explained above, Hammond shows that providing a tab with hole and with or without adhesive thereon are found to be functionally equivalent and it would have been obvious to one having ordinary skill in the art to substitute a tab with hole and adhesive for the tab with hole and no adhesive in the invention of Dills for both tabs would provide for facilitating the removal of the outermost tape layer in the roll or coil.

As for claims 16, 17 and 20, applicant argues that Dills discloses not adhesive on the tab and Hammond does not satisfy the spatial recitations of amended claim 16. This is also not deemed to be convincing because Hammond's tab (s shown in figure-2) shows that a first end portion of non-adhesive portion(f) coincides with a first end of the tab (see the area of (f) located along the

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edge at the near side of the tab). Similarly, the first end portion of the adhesive (g) is located adjacent the second end portion of the non-adhesive portion (f) and the first end position of adhesive (g) coincides with the second end of the tab (see figure-2, the far edge of the tab).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Patricia L. Nordmeyer/
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